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| APPLICATION NO.  | FILING DATE  | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |          |             |          |              |      |  |
|--|--------------|--|---------------------|------------------|----------|-------------|----------|--------------|------|--|
| 09/621,032   | 07/21/2000   | Leslie Gary Graf   | 27795-00018         | 4059             |          |             |          |              |      |  |
| 7590 02/18/2005<br>Jenkins & Gilchrist<br>1445 Ross Avenue, Suite 3200<br>Dallas, TX 75202 |              | <table border="1"> <tr> <td>EXAMINER</td> </tr> <tr> <td>ORGAD, EDAN</td> </tr> </table> <table border="1"> <tr> <td>ART UNIT</td> <td>PAPER NUMBER</td> </tr> <tr> <td>2684</td> <td></td> </tr> </table> |                     |                  | EXAMINER | ORGAD, EDAN | ART UNIT | PAPER NUMBER | 2684 |  |
| EXAMINER   |              |  |                     |                  |          |             |          |              |      |  |
| ORGAD, EDAN  |              |  |                     |                  |          |             |          |              |      |  |
| ART UNIT   | PAPER NUMBER |  |                     |                  |          |             |          |              |      |  |
| 2684   |              |  |                     |                  |          |             |          |              |      |  |

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/621,032

Applicant(s)

GRAF ET AL.

Examiner

Edan Orgad

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,7-9,11,12 and 37-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-9,11,12 and 37-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 2, 7-9, 11, 12 and 37-50 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7, 11, 12, 37-42 & 44-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Haynes et al (GB 2 322 521).

Regarding claims 1, 37 and 44, Haynes teaches a method of negotiating operating capabilities in a telecommunications system including at least one mobile station, the method comprising: receiving a first list of operating capabilities for a first mobile station at a first node upstream of and associated with the first mobile station wherein the list is received prior to setting up a call with the mobile station (page 19, 3<sup>rd</sup> ¶ - page 20, line 3), storing the operating capabilities for the first mobile station at the first node (page 20, 2<sup>nd</sup> ¶ & page 2, 2<sup>nd</sup> ¶), receiving a second list of operating capabilities for a second mobile station at a second node upstream of and associated with the second mobile station wherein the list is received prior to setting the call with the second mobile station, storing the operating capabilities for the second mobile station at the second node (page 25, 1<sup>st</sup> ¶) and comparing the second list to the first list such that the negotiation of agreed upon

operating capabilities take place between the first node and the second node (page 26, 1<sup>st</sup> ¶).

Regarding claims 2, 41 and 48, Haynes teaches the receiving includes: receiving the first list of operating capabilities from the first mobile station via a location update message (page 33, 1<sup>st</sup> ¶).

Regarding claim 7, Haynes teaches selecting the agreed-upon operating capabilities based on operating capabilities that are in common on both lists (page 33, 2<sup>nd</sup> ¶- page 34, 1<sup>st</sup> ¶).

Regarding claim 11, Haynes teaches the first node is any one of a MSC, a VLR, a HLR or a GMSC (figure 1).

Regarding claims 12, 46 and 47, Haynes teaches the second node is a MSC, a VLR, a HLR or a GMSC (figure 1).

Regarding claims 38 and 45, Haynes teaches the storing is performed by a Visitor Location Register (figure 1, element 12).

Regarding claims 39, Haynes teaches the reviewing by the second switch is performed by a Gateway Mobile Switching Center (GMSC) serving the second mobile station (figure 1, elements 32).

Regarding claim 40, Haynes teaches the reviewing by the second switch is performed by a Mobile Switching Center (MSC) serving the second mobile station (figure 1, element 8A).

Regarding claims 42 and 49, Haynes teaches the outgoing call setup message is an Initial Address Message (page 13, 2<sup>nd</sup>, ¶- page 14, 1<sup>st</sup> ¶).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 9, 43 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haynes et al (GB 2 322 521).

Regarding claims 8, 9, 43 and 50, Welling fails to specifically disclose the operating capabilities include codecs and security algorithms. However, official notice is taken that having operating capabilities include codecs and security algorithms is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to have Haynes's already existing operating capabilities include codecs and security algorithms in order to provide Welling with the ability to convert binary signals transmitted on their digital networks to analog signals converted on their analog networks.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,456,843 Method and apparatus for over-the-air programming of telecommunication services.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edan Orgad whose telephone number is 703-305-4223. The examiner can normally be reached on 8:00AM to 5:30PM with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on 703-305-4223. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/9/04  
EDAN ORGAD  
PATENT EXAMINER/TELECOMM